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09/589,313	06/07/2000	Donald Spector	F.11134	8934

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EXAMINER
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ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/589,313

Applicant(s)

SPECTOR, DONALD

Examiner

Raquel Alvarez

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11/5/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to communication filed on 11/5/2003.
2. Claims 1-12 are presented for examination.

#### **Claim Objections**

3. Claim 2 is objected to because of the following informalities: Claim 2 depends from itself. Appropriate correction is required.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. (6,336,099 hereinafter) in view of Von Kohorn (5,249,044 hereinafter Von Kohorn).

With respect to claim 1, Barnett teaches a system for generating discount or promotional coupons (see Abstract). A receiver located at a viewer's premises, said receiver including a communication device (i.e. the user uses personal computer 6 to communicate his coupons request and selections to Online provider 2)(figure 1 and col. 7, lines 1-5),

data processing means, responsive to selections by the viewer, for transmitting a request for a particular coupon to a broadcaster central station via said communication

device (i.e. the users selections are communicated to the Online service provider 2 where the coupons are made public and known to the users)(Figure 1 and col. 6, lines 66-, col. 7, lines 1-5),

means included within said broadcaster central station for transmitting to a manufacturer coupon generator station a coupon request, which request includes a specific information regarding the product of interest (i.e. the Online service provider 2 transmits the specific coupon request and user's data to the coupon distributor 16)(Figure 1),

first means included within said manufacturer's coupon generator station for receiving specific information regarding said product of interest, said manufacture's coupon generator station also having available point-of-sale information regarding said product (i.e. the coupon distributor receives the specific coupon selection and information from the various retail stores as to which coupons are being redeemed)(Figure 1 and col. 5, lines 28-34),

second means included within said manufacturer's coupon generation station for analyzing said specific information regarding said product of interest, and said point-of-sale information and issuing a coupon to said viewer based on said analyzed information(i.e. the information related to the coupons selected is supplied to the coupon distributor 16, and the information obtained from various retailers stores as to which coupons are redeemed in order to more intelligent market subsequent coupons and target coupon issuance in a more cost effective manner)(col. 5, lines 28-34).

With respect to the added feature of receiving up to the minute point-of-sale information on the product of interest and coupon responses and redemptions. Barnett teaches the retailer sending (10) sending point-of-sale information on the product purchased and coupon redemption information for the products purchased to the coupon distributor (Figure 1 and col. 5, lines 28-34). Barnett is silent as to how frequent the point of sale information and redemption information is sent. In Barnett the point of sale information on the products of interest and coupon responses and redemption is sent electronically through a computer network (see Figure 1) and since it is old and well known in computer networks to transmit information and receive information instantly and frequently such as up to the minute then it would have been obvious to a person of ordinary skill in the art to have included receiving information on the product of interest and coupon responses and redemptions up to the minute because such a modification would allow to analyze the information received in real time.

Barnett doesn't specifically teach the receiver being a television receiver consisting of a remote control for coupon selection. On the other hand, Von Kohorn teaches a coupon dispensing system wherein the user television receiver 12 and remote control 14 operated by viewer 13 to generate and dispense tokens or coupons 2 (see figure 1). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have modified the system of Barnett with the teachings of Von Kohorn of the receiver being a television receiver consisting of a remote control for coupon selection because such a modification would increase the usage of the

system of Barnett by implementing it in a common device such as a television and a control remote which is already owned by most households.

With respect to claim 2, Barnett further teaches wherein said request for a coupon includes information specifying a time when said coupon is requested (i.e. demographic data file 42 contains data representative of the time that the user requested the coupon package 40).

Claim 3 further recites that the manufacturer's coupon generator station includes means for comparing the time when the coupon was requested with the time when the product of interest was broadcast. Since, Barnett teaches the coupon distributor (manufacturer) receives selection data for when the coupons are selected and the times when the coupon was viewed (broadcast)(Abstract) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included making a comparison between the time when the coupons are requested from when the time when the coupons are broadcasted because such a modification would allow the manufacturer to better target the incentives or coupons to each user based on the user habits.

With respect to claim 4, Barnett further teaches issuing said coupon at a value intended to provide maximum sales of said product of interest (i.e. the manufacture issues the coupon of interest at the redemption amount 74).

With respect to claim 5, the combination of Barnett and Von Kohorn do not specifically teach a value which varies depending on the geographic location of the user. Nevertheless, a customer located in Alaska would have a greater need for a

winter coat and therefore the coupon distributor may want to vary the value of the coupon accordingly. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included coupon value which varies depending on the geographic location of the viewer because such a modification would provide a more target system based on the customers needs.

With respect to claim 6, Barnett further teaches that said coupon is short life coupon (i.e. certain coupons have to be used/redeemed within one month from the day printed)(col. 11, lines 66-, col. 12, lines 1-8).

With respect to claim 7, Barnett further teaches that the coupon, upon issuance, is printed for said viewer by a printer attached to said data processing means (Figure 1, item 8).

With respect to claim 8, Barnett further teaches that the coupon, upon issuance is electronically stored by said data processing means (i.e. the coupons are stored in the output buffer 28)(col. 11, lines 30-34)

With respect to claim 9, Barnett further teaches that the electronically stored coupon can subsequently be printed or redeemed electronically by said viewer (i.e. the coupon are redeemed electronically by sending the coupon data in the output buffer via the communications interface 20 back to the Online service provider 2)(col. 11, lines 32-38).

With respect to claim 10, Barnett doesn't specifically teach hat the coupon includes inquiries which may be electronically or manually answered by said viewer as part of a contest. On the other hand, Von Kohorn teaches that a token (coupon) is

generated which contains a serial number and customer's information such as the customer's name and that information is used to enter the customers in a contest where they can win additional prizes (col. 8, lines 19-41). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Barnett the teachings of Von Kohorn of the coupon including inquiries which may be electronically answered by said viewer as part of a contest because such a modification would motivate the customers to supply the requested information.

With respect to claim 11, Barnett further teaches assembling and transmitting consumer profile information along with said information regarding the product of interest (i.e. the demographic file 42 along with the user's product selections is assembled and transmitted to the Online service)(see figure 9).

With respect to claim 12, Barnett further teaches wherein said coupon is a promotional coupon (see Figure 5).

### **Response to Arguments**

5. With respect to the submitted form PTO/SB/01, it lists the inventor's address and thereby obviates the objection to the oath/declaration.
6. The claim objections has been withdrawn in light of the amendments to the claims.
7. With respect to Applicant's argument with respect to the newly added feature, of receiving up to the minute point-of-sale information on the product of interest and coupon responses and redemptions. Barnett teaches the retailer sending (10) sending point-of-sale information on the product purchased and coupon redemption information



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for the products purchased to the coupon distributor (Figure 1 and col. 5, lines 28-34). Barnett is silent as to how frequent the point of sale information and redemption information is sent. In Barnett the point of sale information on the products of interest and coupon responses and redemption is sent electronically through a computer network (see Figure 1) and since it is old and well known in computer networks to transmit information and receive information instantly and frequently such as up to the minute would allow to analyze the information received in real time and therefore would allow to issue better current targeted coupons accordingly. For instance, Walker teaches a method and apparatus for selling an aging food product. The system periodically transmits (e.g. every minute) information on products in order to allow up to the minute offers on aged products (col. 3, lines 28-42 and col. 7, lines 57-, col. 8, lines 1-38).

8. On page 8 of the response, Applicant asserted "The Examiner has admitted that the '099 Reference does not teach an interface between an Internet-based computer system". It is noted that the Examiner did not make such an admission. The Examiner statement was "Barnett doesn't specifically teach the receiver being a television receiver consisting of a remote control for coupon selection" and that the feature was taught by Von Kohorn.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the skilled in the art is presumed to have some knowledge of the art. For instance, one skilled in the art given the Von Kohorn reference of receiving and selecting coupons through a television receiver can easily modify the personal computer of Barnett to include the receiver to be a television receiver because such a modification would allow the system to operate with such a well known device such as a television receiver.

10. In response to applicant's argument that Von Kohorn is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Von Kohorn is analogous art because is in the same filed of applicant's endeavor of generating product coupons at remote locations from a central location (see Abstract).

11. With regard to the examiner's use of Official Notice, since, Applicant didn't command a response or request of such personal knowledge such as to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of, the Official notice is sustained. See MPEP 2144.03 where *In re Boon* is mentioned.

12. Applicant argues that there's no indication anywhere in '044 reference to Von Kohorn to POS data collection. The Examiner wants to point out that Von Kohorn

wasn't cited for teaching POS data collection. On the other hand, Barnett '099 reference was cited to teach receiving POS information on the product of interest and redemption information. Applicant further argues that Barnett doesn't teach real time POS information concerning the product for which a coupon will thereafter be issued. The Examiner disagrees with Applicant because the coupons redeemed by the purchaser are presented to a product station 11 along with the associated products for purchase for which the coupons are to be redeemed, the redeemed coupons corresponds to a specific product purchased at the point of sale (col. 7, lines 12-21). This information collected is passed on to the coupon distributor in order to utilize the coupons redeemed, which corresponds to particular products which enable to target subsequent coupons (col. 7, lines 36-55). The coupons redeemed contain redemption amount, company and **product name**, expiration date, etc. and this information is passed to the coupon issuer(see Figure 5). The coupons redeemed contain the user data and the product data which is analyzed to determine subsequent coupon sets (see Figure 9). The coupons redeemed, which contain the specific product name is sent from the retailer/product checkout 10 to the coupon distributor 16 (see Figure 1).

Applicant argues that the POS information is not sent in real time. The Examiner wants to point out that Barnett teaches the retailer sending (10) sending point-of-sale information on the product purchased and coupon redemption information for the products purchased to the coupon distributor (Figure 1 and col. 5, lines 28-34). Barnett is silent as to how frequent the point of sale information and redemption information is sent. In Barnett the point of sale information on the products of interest and coupon

responses and redemption is sent electronically through a computer network (see Figure 1) and since it is old and well known in computer networks to transmit information and receive information instantly and frequently such as up to the minute , up to the minute information would allow to analyze the information received in real time and therefore would allow to issue current better targeted coupons based on the customer current needs.

13. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

14. In light of the above, it is the Examiner's position that Barnett in combination with Von Kohorn teach the claimed limitations.

### **Conclusion**

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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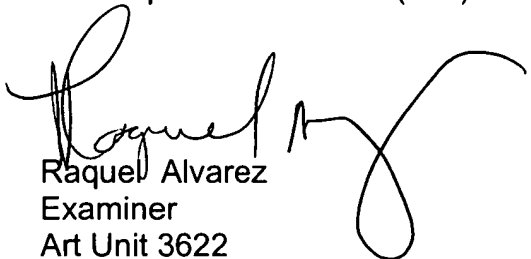
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Point of contact**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

  
Raquel Alvarez  
Examiner  
Art Unit 3622

R.A.  
1/20/04